



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/518,323

10/04/2005

Hamm-Chan Kang

7332P001

6739

8791

7590

11/24/2009

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP  
1279 OAKMEAD PARKWAY  
SUNNYVALE, CA 94085-4040

EXAMINER

PRANGE, SHARON M

ART UNIT

PAPER NUMBER

3728

MAIL DATE

DELIVERY MODE

11/24/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/518,323	<b>Applicant(s)</b> KANG, HAMM-CHAN	
	<b>Examiner</b> SHARON M. PRANGE	<b>Art Unit</b> 3728	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/13/09</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This in response to Applicant's amendment in which claims 1 and 3 were amended, claims 2 and 4 were canceled, and claim 5 was added. The previous objections to the drawings, specification and claims, as well as the previous 35 USC 112 rejections are withdrawn in light of Applicant's amendments.

#### ***Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu (Japanese Patent Application No. 10165203) in view of Miyata (US Patent No. 5,758,435) and Hines (US Patent No. 6,502,331).

Shimizu discloses a plurality of seat holes (3) formed in a bottom sole (1) with metal bodies (weight bodies 4) fixed in the seat holes. As shown in Fig. 1, the size of the seat holes decreases from the heel part of the sole to the front part. Fig. 4 shows that the weight bodies are made to fit closely within the bounds of the seat holes.

Shimizu discloses that the seat holes and weights may be in different shapes and arrangements (Fig. 1, 7), for example strips or small rectangles, but does not disclose round seat holes or weights in the form of balls.

In response to Applicant's arguments, the Hines reference is merely introduced to show that it is well known to provide weights in shoes in different shapes, including balls (spheres). Providing smaller pieces provides easy shaping of the sole to the foot in

Art Unit: 3728

the transverse direction (column 3, lines 3-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the weights in the sole of Shimizu in the shape of a ball, as this would be a simple substitution of one shape for another, with the predictable result of providing greater flexibility in the transverse direction.

Shimizu further does not disclose a layer of insole, middle sole, and cushion layers.

Miyata teaches providing an insole layer (11), middle sole layer (10), sponge layer (14a), and cushion layer (14b) above a sole in a shoe for comfort and shock absorption.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided insole, middle sole, and cushion layers, as taught by Miyata, to the sole of Shimizu in order to provide added comfort and shock absorption to the wearer.

3. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu, Miyata, and Hines, as applied to claim 1, further in view of Burke et al. (US Patent No. 7,100,307), herein Burke.

The combination of Shimizu, Miyata, and Hines does not disclose refraction lines formed at the front of the sole.

Burke teaches the inclusion of grooves formed in the width direction at the front of the sole of a shoe in order to allow improved flexion of the foot within the shoe (column 6, lines 1-7, 41-67; Fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided grooves, as taught by Burke, at the front end of the sole of the combination of Shimizu and Miyata in order to improve the flexion of the foot within the shoe.

### ***Response to Arguments***

4. Applicant's arguments filed 7/13/09 have been fully considered but they are not persuasive.

5. Applicant argues that changing the shape of the weights to a ball would not have been obvious because the shape provides significant and unexpected advantages. However, Hines teaches that it was well known in the art to provide weights in a shoe sole in the form of balls, or spheres. Hines further teaches that the smaller shapes provide for easy shaping of the sole to a foot.

6. Applicant argues that there is no motivation to combine the Shimizu and Miyata references because the Miyata reference teaches away from the use of variable weight chambers. However, Miyata was not introduced in reference to the distribution of the weight within the shoe. Miyata merely teaches that it is desirable to provide insole, midsole, and cushioning layers above a sole layer. Whether or not the weight distribution in the sole is uniform is irrelevant. Applicant further argues that there is no

Art Unit: 3728

motivation to combine Miyata and Shimizu because Miyata alone provides a solution to the stated problem. However, as stated above, it is desirable to combine Miyata with Shimizu in order to provide comfort and shock absorption to the sole of Shimizu.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHARON M. PRANGE whose telephone number is (571)270-5280. The examiner can normally be reached on M-F 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3728

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. M. P./ 11/12/09  
Examiner, Art Unit 3728

/Mickey Yu/  
Supervisory Patent Examiner, Art  
Unit 3728